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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,993	06/02/1999	STEPHEN LESLIE TYLER	169.1322	9943

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EXAMINER

GHEE, ASHANTI

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/323,993	TYLER, STEPHEN LESLIE
	Examiner	Art Unit
	Ashanti Ghee	2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) \_\_\_\_ is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-36 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 June 1999 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ .                    6) Other: \_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed on 06/02/99 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: I/O Interface 42. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Objections***

3. Claims 23 and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 23 and 24 are dependent upon Claim 13. Since Claim 13 is disclosing an apparatus, Claims 23 and 24 both disclose a method for that apparatus in claim 13.

4. Claims 34, 35, and 36 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 34, 35, and 36 are dependent upon Claim 25. Since Claim 25 is disclosing a computer program, Claims 34, 35, and 36 both disclose a method for that computer program in claim 25.

5. As understood by the Examiner, the following rejection is based on the method claims 23-24 and 34-36 being treated as apparatus and computer program claims respectively.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 13, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites the limitation "said invoked manipulation" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 13 recites the limitation "said invoked manipulation" in line 25 of the claim. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 25 recites the limitation "said invoked manipulation" in line 18 of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1-4, 13-16, and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Berg et al. (US Patent No. 6,362,897 B1).

Regarding claim 1, Berg discloses a method for manipulating an electronic document automatically created by an application program, said method comprising the steps of: identifying a user involved manipulation (user touching the listing of document) of said electronic document to determine if said invoked manipulation is one of a predetermined group (inherent in "ACTION SCREEN") of manipulations (column 6, lines 35-61); wherein if said invoked manipulation is not a member ("VIEW DOCUMENT") of said group, allowing said invoked manipulation to proceed (column 6, lines 35-column 7, lines 1-21); or if said invoked manipulation is a member ("PRINT DOCUMENT") of said group, allowing said manipulation to proceed only in respect of a predetermined portion (limiting printing to a predetermined total number of copies and forms) of said electronic document (column 6, lines 35-column 7, lines 1-21).

Regarding claim 2, Berg discloses a method according to claim 1, wherein said predetermined portion comprises a predetermined number of pages (predetermined total number of copies of documents and forms) of said electronic document (column 7, lines 5-21).

Regarding claim 3, Berg discloses a method according to claim 1 or 2, wherein said group includes a printing function (column 6, lines 35-61).

Regarding claim 4, Berg discloses a method according to claim 3, wherein said printing function is the only member of said group (column 6, lines 35-47).

Regarding claim 13, Berg discloses an apparatus for manipulating an electronic document automatically created by an application program, said apparatus comprising: identifying means for identifying a user involved manipulation (user touching the listing of document) of said electronic document to determine if said invoked manipulation is one of a predetermined group (inherent in "ACTION SCREEN") of manipulations (column 6, lines 35-column 7, lines 1-21); allowing means for allowing said invoked manipulation to proceed if said invoked manipulation is not a member ("VIEW DOCUMENT") of said group; or if said invoked manipulation is a member ("PRINT DOCUMENT") of said group, allowing said manipulation to proceed only in respect of a predetermined portion (limiting printing to a predetermined total number of copies and forms) of said electronic document (column 6, lines 35-column 7, lines 1-21).

Regarding claim 14, Berg discloses an apparatus according to claim 13, wherein said predetermined portion comprises a predetermined number of pages of said electronic document (column 7, lines 5-21).

Regarding claim 15, Berg discloses an apparatus according to claim 13 or 14, wherein said group includes a printing function (column 6, lines 35-61).

Regarding claim 16, Berg discloses an apparatus according to claim 15, wherein said printing function is the only member of said group (column 6, lines 35-47).

Regarding claim 25, Berg discloses a computer program product comprising a computer usable medium having computer readable program code means embodied in said medium for manipulating an electronic document automatically created by an application program, said product including: identifying means for identifying a user

involved manipulation (user touching the listing of document) of said electronic document to determine if said invoked manipulation is one of a predetermined group (inherent in "ACTION SCREEN") of manipulations (column 6, lines 35-column 7, lines 1-21); allowing means for allowing said invoked manipulation to proceed if said invoked manipulation is not a member ("VIEW DOCUMENT") of said group; or if said invoked manipulation is a member ("PRINT DOCUMENT") of said group, allowing said manipulation to proceed only in respect of a predetermined portion (limiting printing to a predetermined total number of copies and forms) of said electronic document (column 6, lines 35-column 7, lines 1-21).

Regarding claim 26, Berg discloses a computer program product according to claim 25, wherein said predetermined portion comprises a predetermined number of pages of said electronic document (column 7, lines 5-21).

Regarding claim 27, Berg discloses a computer program product according to claim 25 or 26, wherein said group includes a printing function (column 6, lines 35-61).

Regarding claim 28, Berg discloses a computer program product according to claim 27, wherein said printing function is the only member of said group (column 6, lines 35-47).

#### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5-12, 17-24, and 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg et al. (US Patent No. 6,362,897 B1) in view of Dubbels et al. (US Patent No. 6,222,634 B1).

Regarding claim 5, Berg does not disclose a method according to claim 1, wherein said electronic document represents a conglomeration of user selected documents obtained via a traversal of a computer network.

However, Dubbels discloses a method according to claim 1, wherein said electronic document (pages) represents a conglomeration of user selected documents (a list of related web pages) obtained via a traversal of a computer network (Internet 170 reads on computer network; column 5, lines 50-column 6, lines 1-61).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Berg and Dubbels due to both references disclosing printing documents to provide a user with the ability of printing related web pages without manual invoking and printing each page.

Regarding claim 6, Berg discloses a method according to claim 5, wherein said predetermined portion comprises a predetermined number of said selected documents (column 7, lines 5-21).

Regarding claim 7, Berg does not disclose a method according to claim 6, wherein associated with each said selected document of said combination is a document location identifier, and said predetermined portion is determined using said document location identifiers.

However, Dubbels discloses a method according to claim 6, wherein associated with each said selected document of said combination is a document location identifier (URL), and said predetermined portion is determined using said document location identifiers (column 5, lines 50-column 6, lines 1-61).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Berg and Dubbels due to both references disclosing printing documents to provide a user with the ability of printing related web pages without manual invoking and printing each page.

Regarding claim 8, Berg discloses a method according to anyone of claims 5 to 7, wherein said manipulation is allowed to proceed only in respect of a predetermined portion of each said electronic documents (column 7, lines 5-21).

Regarding claim 9, Berg discloses a method according to claim 8, wherein said predetermined portion comprises a predetermined number of pages of an electronic document (column 7, lines 5-21).

Regarding claim 10, Berg discloses a method according to any one of claims 5 to 7, wherein said group includes a printing function (column 6, lines 35-61).

Regarding claim 11, Berg discloses a method according to any one of claims 5 to 7 wherein said printing function includes a print reduction function (evident in phrase 'may cause the portion of the document displayed to be changed upon entry of a user-entered command'; column 6, lines 35-column 7, lines 1-4).

Regarding claim 12, Berg discloses a method according to anyone of claims 5 to 7, wherein said printing function includes a print preview function (column 6, lines 35-column 7, lines 1-4).

Regarding claim 17, Berg does not disclose an apparatus according to any one of the claims 13, wherein said electronic document represents a conglomeration of user selected documents obtained via a traversal of a computer network.

However, Dubbels discloses an apparatus according to any one of the claims 13, wherein said electronic document represents a conglomeration of user selected documents obtained via a traversal of a computer network (column 5, lines 50-column 6, lines 1-61).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Berg and Dubbels due to both references disclosing printing documents to provide a user with the ability of printing related web pages without manual invoking and printing each page.

Regarding claim 18, Berg discloses an apparatus according to claim 17, wherein said predetermined portion comprises a predetermined number of said selected documents (column 7, lines 5-21).

Regarding claim 19, Berg does not disclose an apparatus according to claim 18, wherein associated with each said selected document of said combination is a document location identifier, and said predetermined portion is determined using said document location identifiers.

However, Dubbels discloses an apparatus according to claim 18, wherein associated with each said selected document of said combination is a document location identifier, and said predetermined portion is determined using said document location identifiers (column 5, lines 50-column 6, lines 1-61).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Berg and Dubbels due to both references disclosing printing documents to provide a user with the ability of printing related web pages without manual invoking and printing each page.

Regarding claim 20, Berg discloses An apparatus according to anyone of claims 17 to 19, wherein said manipulation is allowed to proceed only in respect of a predetermined portion of each said electronic documents (column 7, lines 5-21).

Regarding claim 21, Berg discloses an apparatus according to claim 20, wherein said predetermined portion comprises a predetermined number of pages of an electronic document (column 7, lines 5-21).

Regarding claim 22, Berg discloses an apparatus according to anyone of claims 17 to 19, wherein said group includes a printing function (column 6, lines 35-61).

Regarding claim 23, Berg discloses a method according to anyone of claims 17 to 19, wherein said printing function includes a print reduction function (evident in phrase 'may cause the portion of the document displayed to be changed upon entry of a user-entered command'; column 6, lines 35-column 7, lines 1-4).

Regarding claim 24, Berg discloses a method according to anyone of claims 17 to 19, wherein said printing function includes a print preview function (column 6, lines 35-column 7, lines 1-4).

Regarding claim 29, Berg does not disclose a computer program product according to anyone of claims 25, wherein said electronic document represents a conglomeration of user selected documents obtained via a traversal of a computer network.

However, Dubbels discloses a computer program product according to anyone of claims 25, wherein said electronic document represents a conglomeration of user selected documents obtained via a traversal of a computer network (column 5, lines 50-column 6, lines 1-61).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Berg and Dubbels due to both references disclosing printing documents to provide a user with the ability of printing related web pages without manual invoking and printing each page.

Regarding claim 30, Berg discloses a computer program product according to claim 29, wherein said predetermined portion comprises a predetermined number of said selected documents (column 7, lines 5-21).

Regarding claim 31, Berg does not disclose a computer program product according to claim 30, wherein associated with each said selected document of said combination is a document location identifier, and said predetermined portion is determined using said document location identifiers.

However, Dubbels discloses a computer program product according to claim 30, wherein associated with each said selected document of said combination is a document location identifier (URL), and said predetermined portion is determined using said document location identifiers (column 5, lines 50-column 6, lines 1-61).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Berg and Dubbels due to both references disclosing printing documents to provide a user with the ability of printing related web pages without manual invoking and printing each page.

Regarding claim 32, Berg discloses a computer program product according to anyone of claims 29 to 31, wherein said manipulation is allowed to proceed only in respect of a predetermined portion of each said electronic documents (column 7, lines 5-21).

Regarding claim 33, Berg discloses a computer program product according to claim 32, wherein said predetermined portion comprises a predetermined number of pages of an electronic document (column 7, lines 5-21).

Regarding claim 34, Berg discloses a method according to any one of claims 29 to 31, wherein said group includes a printing function (column 6, lines 35-61).

Regarding claim 35, Berg discloses a method according to any one of claims 29 to 31, wherein said printing function includes a print reduction function (evident in phrase 'may cause the portion of the document displayed to be changed upon entry of a user-entered command'; column 6, lines 35-column 7, lines 1-4).

Regarding claim 36, Berg discloses a method according to anyone of claims 29 to 31, wherein said printing function includes a print preview function (column 6, lines 35-column 7, lines 1-4).

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Ferguson et al.** (US Patent Number 5,819,092) discloses an online service development tool with fee setting capabilities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashanti Ghee whose telephone number is (703) 306-3443. The examiner can normally be reached on Monday-Friday (7AM - 4PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7455 for regular communications and (703) 746-7455 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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Ashanti Ghee  
Examiner  
Art Unit 2622

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December 16, 2002

  
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